



Attorney's Docket No.: 02108-211002

g/p 2644
#22
P.D.
1-10-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Donald F. Hamilton et al.
Serial No. : 08/777,958
Filed : December 24, 1996
Title : VEHICLE TRUNK WOOFER

Art Unit : 2644
Examiner : Ping Lee

Hon. Commissioner for Patents
Washington, D.C. 20231

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Technology Center 2600

RESPONSE B

Dear Commissioner:

Responsive to the office action dated July 19, 2002, reconsideration of the rejection of claims is respectfully requested in the light of the following remarks and authorities.

1. The prosecution is said to have been reopened under 37 C.F.R. §1.198. These provisions read as follows:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of §1.114 or §1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown. [65 FR 14873, Mar. 20, 2000]

The Examiner has not and cannot cite any authority under 37 C.F.R. §1.114 or §1.196 that authorizes reopening, nor has the Examiner obtained the written authority of the Commissioner.

That is reason enough for issuing a Notice of Allowance forthwith.

As M.P.E.P. 1214.04 headed Examiner Reversed directs, "The Examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

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CHARLES HICKEN

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2, 3. Claims 1-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by BAZOOKA Bass Tubes in Car Audio and Electronics. Regarding claim 1, it is said that on the lower half of p. 41, a vehicle sedan is said to be shown. It is said a low frequency speaker (Bazooka woofers) is said to be disposed within the trunk of the vehicle clear of the rear deck, above the trunk floor and outside the spare tire compartment. Although not explicitly discussed, it is said the sedan (Honda Accord, Toyota Camry, Nissan Pulse, Nissan 200SX, BMW or Mercedes) is said to inherently include a spare compartment, trunk floor, a dividing portion and a rear deck. Regarding claims 5 and 10, it is said the limitation of these claims are said to be no functionally related to the limitation in claims 1 and 6 since it is said the claims never specify that the claimed frequency responses are caused by the woofer being placed in the trunk, not mounted on the rear deck as disclosed in the specification as originally filed as the prior art. With the low frequency speaker disposed in the trunk is said to be shown on page 41, not conventionally mounted on the rear deck, the claimed frequency responses are said to be inherently met as said to be discussed on page 1 of the specification, the low frequency speaker mounted on the rear deck it is said will cause a hole between 60-80 Hz for the front seat and a hole between 80-100 Hz for the back seat.

Regarding claims 2, 3, 7 and 8, the low frequency speaker is said to be disposed in a rearward section of the trunk, with specific reference to the statement that the BAZOOKA woofers can be directed into the rearmost corner of the trunk shown, or they can be located directly behind the back seat, whichever is preferable, and is said to be disposed in a rear trunk corner at the rear of the vehicle as said to be shown in the diagram. Regarding claims 4 and 9 as said to be shown on page 41, the low frequency speaker is said to be mounted in an enclosure. regarding claim 6 as said to be shown on page 41, the rear deck is said to be free of speaker holes when the low frequency speaker is placed on the trunk floor.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as

arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

"A reference is only good for what it clearly and definitely discloses." *In re Hughes*, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961).

The copy of the BAZOOKA page furnished to us contains no page number or date and the drawings are faint white lines on a black background that nevertheless fails to disclose anything that anticipates the invention disclosed and claimed in this application.

Claim 1 requires that the low frequency speaker be disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck above the trunk floor and outside the spare tire compartment. The reference shows the large BAZOOKA tubes extending from front to rear in the trunk IN the location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle.

Claims 2 and 7-10 call for the at least one speaker being disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said one speaker mounted in said rear deck.

Manifestly, the large BAZOOKA disclosed in the reference occupies considerable volume in the trunk.

Claims 5 and 10 further require that the vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle. There is no disclosure whatsoever of the audio speaker system disclosed in the reference having this characteristic.

Furthermore, claims 6-10 call for the rear deck being free of speaker holes. There is no disclosure in the reference of the rear deck being free of speaker holes.

Accordingly, withdrawal of the rejection of claims 1-10 as being anticipated by the reference is respectfully requested.

If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim.

4. Claims 1, 2, 4-7, 9 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ziffer. Regarding claim 1, a vehicle sedan is said to be shown on pages 46-48. A low frequency speaker said to be BAZOOKA bass tubes is said to be disposed within the trunk of the vehicle clear of the rear deck, above the trunk floor and outside the spare tire compartment. Although not explicitly discussed, the vehicle is said to inherently include a spare tire compartment, a trunk floor, a dividing portion and a rear deck.

Regarding claims 5 and 10, the limitation of these claims are said to be not functionally related to the limitation in claims 1 and 6 since the claims never specify that the claimed frequency responses are caused by the woofer being placed in the trunk, not conventionally mounted on the rear deck as disclosed in the specification as originally filed. With the low frequency speaker as disposed in the trunk as said to be shown on page 48, not conventionally mounted on the rear deck, the claimed frequency responses are said to be inherently met as said to be discussed on page 1 of the specification, the low frequency speaker mounted on the rear deck will cause a hole between 60-80 Hz for the front seat, and a hole between 80-100 Hz for the back seat.

Regarding claims 2 and 7, the low frequency speaker is said to be disposed in a rearward section of the trunk, it being said the top picture on page 48 shows the speaker is disposed on the rearward section of the trunk when one opens the trunk hood and views the speaker from the rear of the vehicle.

Regarding claims 4 and 9 as said to be shown on page 48, the low frequency speaker is mounted in an enclosure.

Regarding claim 6, as said to be shown on page 48, the rear deck is said to be free of low frequency speaker holes when the low frequency speaker is placed on the trunk floor. As said to be discussed by the entire article, no speaker is being mounted on the rear deck.

This ground of rejection is respectfully traversed.

There is no disclosure in the reference of having the low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger

compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck above the trunk floor and outside the spare tire compartment as called for by all the claims. The poor quality copy of the reference furnished to us discloses the large BAZOOKA bass tubes extending from front to rear IN the portion of the trunk extending to the front of the vehicle. There is no disclosure that the BAZOOKA bass tubes are disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with the one speaker mounted in the rear deck as called for by claims 2, 3 and 7-10. There is no disclosure of an audio speaker system wherein the vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle as called for by claims 5 and 10. Nor does the reference disclose that the rear deck is free of speaker holes as called by claims 6-10.

Accordingly withdrawal of the rejection of claims 1, 2, 4-7, 9 and 10 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in the rejected claims.

5, 6. Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over BAZOOKA Bass Tubes in Car Audio and Electronics. It is said that the current invention as specified in claims 1-10 does not require an audio input signal. Therefore it is said the limitation of the claims will also be met when someone purchases a woofer from a store and places it above the trunk floor. It is said it would have been obvious to one of ordinary skill in the art to hide a purchased low frequency speaker within the trunk, above the trunk floor, outside of the spare tire compartment, just like placing a luggage in order to reduce the chance of being stolen.

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

We have shown above how it is impossible for this reference to anticipate claims 1-10. Nor is there any suggestion in the reference of modifying what is there disclosed to meet the terms of claims 1-10. Accordingly, withdrawal of the rejection of claims 1-10 as unpatentable over the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the terms of claims 1-10.

7. Claims 1, 2, 4-7, 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ziffer. It is said that the current invention as specified in these claims does not require an audio input signal. Therefore, it is said the limitation of the claims will also be met when someone purchases a woofer from a store and places it above the trunk floor. It is said it would have been obvious to one of ordinary skill in the art to hide a purchased low frequency speaker within the trunk, above the trunk floor, outside of the spare tire compartment, just like placing a luggage in order to reduce the chance of being stolen.

We have shown above how it is impossible to anticipate claims 1, 2, 4-7, 9 and 10 by the reference. The Examiner has not identified anything in the reference which suggests the desirability of modifying what is there disclosed to meet the terms of these claims. Accordingly, withdrawal of the rejection of the claims 1, 2, 4-7, 9 and 10 as unpatentable over the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in each rejected claim, and quote verbatim the language in the reference regarded as suggesting the desirability of modifying what is there disclosed to meet the terms of these claims.

8. Claims 3 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ziffer as a primary reference in view of van Rijsbergen or BAZOOKA Bass Tubes as a secondary reference. Regarding claims 3 and 8, the primary reference is recognized as failing to show the low frequency speaker being disposed in the rear trunk corner at the rear of the vehicle. However, such a modification it is said would have been an obvious design choice of the audio system installer without altering the overall sound quality. As said to be taught by the van Rijsbergen secondary reference, bass tone will travel through the car readily, so the placement of

the low range speakers can be quite flexible and one can use his/her imagination a little and find a place for woofers which would not otherwise fit in conventional mounting positions, with specific reference to page 21. The primary reference is said to disclose a custom fit design audio system for a vehicle. It is said the audio system installer would place the low frequency speaker at the location with minimal compromise of trunk space, with specific reference to page 48, and as approved by the owner of the vehicle. By placing the low frequency speaker at the trunk corner at the rear of the vehicle, one skilled in the art it is said would have expected that more space would be available behind the back seat so the user could place luggage, articles, boxes or other infrequently used objects below the rear deck. The other article is said to also teach that the bass tube can be placed either behind the back seat or at the rear corner of the trunk at the rear of the vehicle as said to be shown depending on the preference. Thus, it is said it would have been obvious to one of ordinary skill in the art to modify the audio system as disclosed by the primary reference in view of either secondary reference by locating the low frequency speaker at the rear trunk corner at the rear of the vehicle in order to provide more trunk space behind the back seat. Furthermore, it is said applicant discloses that any rear remote area of the trunk would be acceptable locations for the low frequency speaker, and without specifying the reason to locate the speaker at the rear corner of the trunk of the rear of the vehicle other than a preference. Shifting the location of the low frequency speaker in order to save trunk space and depending on preference is said to be not a patentable invention, it is said to merely involve common sense and/or mechanical skill in order to save space and/or better suit the preference of the user of the vehicle. Thus, it is said it has been held to be within the general skill of a worker in the art to rearrange the location of the low frequency speaker as a matter of design choice, with specific reference to *In re Japikse*, 86 U.S.P.Q. 70 (C.C.P.A 1950).

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art

suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

The Examiner concedes that the primary reference fails to show the low frequency speaker being disposed in the rear trunk corner at the rear trunk corner of the vehicle. It is impossible to put these large BAZOOKA bass speakers in the rear trunk corner at the rear of the vehicle, and nothing in any of the references suggests the desirability of modifying anything there disclosed to meet the terms of claims 3 and 8. Accordingly, withdrawal of the rejection of claims 3 and 8 as unpatentable over the primary reference in view of either secondary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to elements in claims 3 and 8 and quote verbatim the language in any of the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of claims 3 and 8.

What the Examiner has done is used the claims being rejected as a blueprint or template for attempting to read the claims upon the prior art. That basis for rejection is not permitted.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritsch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

Furthermore, rejections based on obvious design choice is a conclusion, not a reason for rejecting claims under Section 103. In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

The reliance on *In re Japikse*, 86 U.S.P.Q. 70 (C.C.P.A. 1950) is inapposite. Apart from the decision ruling on "invention" before Section 103 was enacted in the Patent Act of 1952, the factual situation is completely different from that involved in this application. After discussing

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the confusing prosecution below where the court said, "We think it is regrettable that, if the examiner who prepared the statement following the appeal to the board was of the opinion that the prior art cited in the decision declared final by the first examiner was so deficient that the citation of additional art was required, he did not indicate that opinion clearly, because much confusion might have been avoided thereby," *id.* at 72, the Court found no error in the holding as to claim 3 where the claim read on a single reference where it was held that there would be no invention in shifting the starting switch disclosed by the reference to a different position since the operation of the device would not thereby be modified. *Id.* at 73.

The PTO is obligated to follow the authorities set forth above.

We take this occasion to explain what precedents are considered binding in proceedings in the Patent and Trademark Office (PTO). Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. See *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982)(in banc); *Bar Zell Expeditors, Inc. v. United States*, 698 F.2d 1210, 1211 n. 4 (Fed. Cir. 1983). In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps. *Ex parte Holt*, 19 U.S.P.Q. 2d 1211, 1214 (BPA&I 1991).

In view of the foregoing authorities, reasoning, and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe this application is still not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what steps she believes are necessary to place the application in a condition for allowance.

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The Commissioner is respectfully requested to apply any charges to Deposit Account
No. 06-1050, Order No. 02103-211002.

Respectfully submitted,
FISH & RICHARDSON P.C.

OCT 21 2002

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